covered by this patent is like that in *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*[2] which also covered a machine in which a number of old elements were combined in a way in which they had not previously been combined, i.e. in a new combination. But unlike the *Anderson* case, it is conceded that in the case at bar the combined effect of the old elements in the combination is sufficiently greater than the sum of its parts, i.e. sufficiently synergistic, to support a valid patent grant.

However, the result of the test of infringement employed by the courts below is that the patentee can exclude *every* machine which employs the same old elements and which achieves the unpatentable result first achieved by the patented machine, whether or not the synergism which conferred patentability upon the patentee's combination is found in the accused machine.

Respondent argues that the district court has rejected the contentions which Petitioners make here by finding that "the accused machine had all six elements called for in Claim 4 of the patent in suit and that the accused machine and the patented machine were substantially identical and that the ice products of both machines were substantially identical." Thus, respondent argues, "if the patented machine is 'synergistic' the accused machine is equally 'synergistic'." The speciousness of this syllogism lies, of course, in ignoring just what it was that the court below was considering when it found "substantial identity." If the district court confined its inquiry to a search for each of the six (old) elements in the accused machine and to a determination that each of those elements functions as it does in the patented machine, then despite the fact that the patentable improved interaction of those elements (i.e. synergism)

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[2] 90 S.Ct. 305 (1969).

was neither looked for nor found in the accused machine, it can readily find the accused and patented machines to be "substantially identical." This is precisely the inquiry which the district court made as a preliminary to its conclusion of substantial identity. Thus, what respondent implies to constitute a finding of fact is in reality a legal conclusion arrived at by using the misleading test for infringement which this Court is herein urged to reject.

CONCLUSION

The test of infringement of combination patents employed by the court below, and currently by federal courts in patent cases generally, ignores whether the accused device employs the synergistic cooperation of the elements in the combination with the result that devices which do not employ nor enjoy that synergistic effect are found to infringe. This was the result below in the case at bar. Review of this test for infringement by this Court is necessary to prevent circumvention of the policy of the *Anderson's-Black Rock* case.

Respectfully submitted,

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